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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,739	02/21/2002	Walter Callen	09010-107001 / DIVER1530-	1077
20985	7590	06/30/2004	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			RAO, MANJUNATH N	
			ART UNIT	PAPER NUMBER
			1652	
DATE MAILED: 06/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/081,739	CALLEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Manjunath N. Rao, Ph.D.	1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-122 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-122 are currently pending in this application.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-29, 47-48, 74-92, 101-106, drawn to a polynucleotide with SEQ ID NO:1, vectors, host cells comprising the same, probes for the same and a method of making a polypeptide using the polynucleotide, classified in class 435, subclass 69.1.
- II. Claims 30-42, 93-94, drawn to a polypeptide with SEQ ID NO:2 having amylase activity, classified in class 435, subclass 200.
- III. Claims 43-46, drawn to an antibody, classified in class 530, subclass 387.5.
- IV. Claims 49-62, drawn to a method of generating a variant, classified in class 435, subclass 4/6.
- V. Claim 63, drawn to a computer medium, classified in class 712, subclass 1.
- VI. Claims 64-67, drawn to a computer system, classified in class 712, subclass 1.
- VII. Claims 68-69, drawn to method of comparing sequences, classified in class 435, subclass 4.
- VIII. Claim 70, drawn to a method of identifying features in a sequence , classified in class 435, subclass 4/6.
- IX. Claims 71-72, 107, 115, 119, 120 drawn to a method of hydrolyzing starch, classified in class 435, subclass 41.

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- X. Claim 73, drawn to an assay for identifying a polypeptide, classified in class 435, subclass 4.
- XI. Claims 95-100, drawn to a method for modifying small molecules, classified in class 435, subclass 4.
- XII. Claims 108-110, drawn to liquefied starch, classified in class 536, subclass 1.11.
- XIII. Claim 111, drawn to a method for washing an object, classified in class 435, subclass 41.
- XIV. Claim 112, drawn to a method of textile desizing, classified in class 435, subclass 263.
- XV. Claim 113, drawn to a method of treating lignocellulosic fibers, classified in class 435, subclass 261.
- XVI. Claim 114, drawn to method of enzymatic deinking of recycled paper, classified in class 435, subclass 278.
- XVII. Claim 116-117, drawn to a detergent additive, classified in class 510, subclass 114.
- XVIII. Claim 118-120, drawn to a method for producing high maltose or high-glucose syrup, classified in class 435, subclass 99.
- XIX. Claims 121-122, drawn to a method of increasing the flow of production fluids , classified in class 435, subclass 262.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I, II, III, V, VI, XII, XVII are patentably distinct from each other. These inventions are all various products differing from each in terms of physical and chemical properties and used for various purposes, do not require each other for practice; have separate utilities, and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Inventions IV, VII-XI, XIII-XVI, XVIII-XIX are all methods patentably distinct from each other. The methods of the above groups are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions II and IV, VII-XI, XII-XVI, XVII-XIX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide can be used for raising specific antibodies as opposed to the uses listed in the groups above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

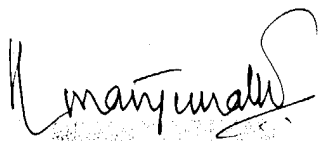
***Rejoinder of restricted inventions***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. **Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112.** Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process

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claims may be maintained. **Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined.** See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to rejoin, in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao  
June 28, 2004